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OFFICE OF PETITIONS

In re Application of :
Gallo et al. : DECISION ON APPLICATION
Application No. 10/766,990 : FOR
Filed: January 28, 2004 : PATENT TERM ADJUSTMENT
Attorney Docket No. :
34544/US/2/AMP/SKS :

This is a decision on the "REQUEST FOR RECONSIDERATION OF THE PATENT TERM ADJUSTMENT" filed December 22, 2006. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b)(3)(B)(i) be corrected from four hundred twenty-five (425) days to four hundred thirty (430) days.

The application for patent term adjustment is **DISMISSED**.

On September 26, 2006, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 425 days. On December 22, 2006, applicants timely¹ submitted an application for patent term adjustment (with required fee). Applicants dispute the period of reduction of 5 days associated with the response received September 6, 2006. Applicants point to the Certificate of Mailing dated August 31, 2006 on the response.. Applicants argue that given the date of the certificate of mailing no reduction should have been entered.

¹ PALM records indicate that the Issue Fee payment was also received on December 22, 2006.

The record supports a conclusion that the application is not subject to a terminal disclaimer.

Applicants are incorrect. 37 CFR § 1.704(b) provides that:

With respect to the grounds for adjustment set forth in §§ 1.702(a) through (e), and in particular the ground of adjustment set forth in § 1.702(b), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

The issue in determining whether an applicant has failed to engage in reasonable efforts to conclude prosecution within the meaning of § 1.704(b) is whether applicant has caused their response to be received in the Office within 3 months of the mailing date of the Office communication. The issue is not timeliness. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period. 37 CFR 1.7 is relevant for determining timeliness and is not relevant to a determination of whether applicant has failed to engage in reasonable efforts to conclude prosecution or examination. By definition, filing a paper outside of the three-month period is a failure to engage.

As stated in MPEP 2731, applicants may wish to consider the use of the "Express Mail Post Office to Addressee" service of the United States Postal Service (37 CFR 1.10) or facsimile transmission (37 CFR 1.6(d)) for replies to be accorded the earliest possible filing date for patent term adjustment calculations. Alternatively, applicants may choose to mail

correspondence with sufficient time to ensure that the correspondence is received in the Office (and stamped with a date of receipt) before the expiration of the three-month period.

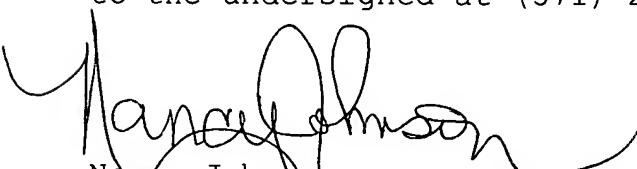
Accordingly, pursuant to § 1.704(b), the period of adjustment was properly reduced by 5 days, the number of days, beginning on September 2, 2006, the day after the date that is three months after the date of mailing of the non-final Office action, and ending on September 6, 2006, the date of filing of the reply.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is four hundred twenty-five (425) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Publications Division for issuance of a patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.


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